

**REMARKS**

In light of the following remarks, reconsideration of the present application is requested. Claims 1-28 are pending in this application. Claims 1, 11, 17 and 23 are independent claims. No new matter has been added.

**Rejections under 35 U.S.C. § 103**

I. Claims 1-9 and 11-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamane et al. (US 5,784,528), hereinafter "Yamane," in view of Taira et al. (US 2003/0113096), hereinafter "Taira." Applicants traverse this rejection for the following reasons.<sup>1</sup>

Claim 1 requires, inter alia, "prohibiting reproduction path re-change to a most recent previous path after reproduction path change." At least this feature is not disclosed or suggested by Yamane, Taira or a combination of the two (assuming they can be properly combined, which Applicants do not admit).

Yamane discloses a method and apparatus for interleaving a bit stream wherein split data units for a defined volume of data for each of a plurality of scenes are distributed at an appropriate level, to prevent a data underflow state. However, as admitted by the Examiner on page 3 of the January 27, 2009 Office Action, Yamane does not disclose or suggest prohibiting the reproduction path re-change to a most recent previous path. Instead, the Examiner relies on Taira for this teaching.

Taira discloses a playback screen wherein some or all of a plurality of angles or scenes can be played back simultaneously. Paragraph [0340] of Taira discloses an

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<sup>1</sup> To be thorough, further expedite prosecution, and for the sake of clarity, Applicants provide discussions of each of the references separately, however, Applicants are not attacking these references individually, but arguing that the references, even taken in combination, fail to render the claimed invention obvious because all features of claim 1 are not found in the prior art.

example of seamless angle switching. More specifically, paragraph [0340] of Taira provides the following:

The angle cannot be immediately switched from the second unit of angle #2 (AGL2-2) to the second unit of angle #3 (AGL3-2) for the following reason. That is, the two angle units (AGL2-2 and AGL3-2) form an angle block to be played back in an identical time band. The unit of seamless angle switching is each ILVU that forms an angle playback unit. However, when angle switching is done between ILVUs in an identical time band (the ILVUs of AGL2-2 and AGL3-2), the flow of movie playback becomes temporally discontinuous (non-seamless), and temporally continuous, seamless angle switching cannot be done until the next angle block (AGL3-3). For this reason, the angle is prohibited from being immediately switched from the second unit of angle #2 (AGL2-2) to the second unit of angle #3 (AGL3-2).

To teach the “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” of claim 1, the Examiner relies on the above-recited portion of Taira and states, “consider the assumption that the angle #3 was being played back before it is switched to playback of angle #2.”<sup>2</sup>

Even assuming the Examiner’s assumption to be true (which Applicants do not admit), Taira still switches from angle #2 to angle #3. As disclosed above, the second unit of angle #2 (AGL2-2) switches to the third unit of angle #3 (AGL3-3). Thus, even assuming that angle #3 was being played back before it is switched to the playback of angle #2, angle #2 still switches back to angle #3.

Accordingly, Taira fails to disclose or suggest “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” as required by claim 1. By contrast, Taira switches angles regardless of the most recent angle.

Furthermore, regarding the Examiner’s assumption, “the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish inherency of that result or characteristic.” MPEP § 2112(IV). Probabilities or

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<sup>2</sup> Non-Final Office Action for U.S. Pat. Appln. No. 11/720,121, p. 3 (January 27, 2009).

possibilities are not sufficient. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-1951 (Fed. Cir. 1999). “The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *Id.*

The Examiner has not established that “prohibiting reproduction path re-change to a most recent previous path after reproduction path change,” is inherent to the disclosure of Taira. Moreover, paragraph [0340] of Taira provides the opposite because angles can be switched back and forth regardless of the previous angle.

Consequently, Yamane in view of Taira fails to render claim 1 obvious. Claims 2-9, which are dependent on claim 1, are patentable for at least the reasons set forth above regarding claim 1.

Claims 11, 17 and 23 are separate independent claims from claim 1, wherein each independent claim contains its own individual limitations. Each independent claim should be interpreted solely based upon limitations set forth therein. However, claims 11, 17 and 23 are patentable for at least reasons somewhat similar to those set forth above regarding claim 1. Claims 12-16, 18-22 and 24-28, which are dependent on claim 11, 17 or 23, are patentable for at least the reasons set forth above.

**II.** Claim 10 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Yamane in view of Taira and Fujiwara et al. (US 2003/0113096), hereinafter “Fujiwara.” Applicants traverse this rejection for the following reasons.

The Examiner correctly acknowledges that the features of claim 10 are absent from Yamane in view of Taira, but alleges that these features are taught by Fujiwara, thereby rendering claim 10 obvious to one of ordinary skill at the time of the invention. Even assuming *arguendo* that the features of claim 10 are taught by Fujiwara (which Applicants do not admit) and that Fujiwara could be properly combined with Yamane

and Taira (which Applicants do not admit), Yamane, Taira and Fujiwara are still deficient with respect to the above-described features of claim 1. Thus, even in combination, Yamane, Taira and Fujiwara fail to render claim 10 obvious.

For at least the foregoing reasons, Applicants respectfully request that the Examiner withdraw the rejections under 35 U.S.C. § 103.

**CONCLUSION**


In view of the above remarks and amendments, the Applicants respectfully submit that each of the pending objections and rejections has been addressed and overcome, placing the present application in condition for allowance. A notice to that effect is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to contact the undersigned.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the undersigned at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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